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Reply dated 2 August 2006
Responsive to Office Action mailed on 13 July 2006

REMARKS

Claim Rejections Under 35 U.S.C. § 102

Claims 16-19 were rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,461,342 to Tanji *et al.* These rejections are respectfully traversed on the ground that the cited reference fails to disclose all of the elements of any of the rejected claims.

It is respectfully noted that in the Office Action, various elements of the two distinct embodiments disclosed by Tanji *et al.* were mixed, *i.e.*, elements from one embodiment were incorrectly stated to be included in the other embodiment. Despite this confusion, a sincere attempt is made in this Reply to address the rejections.

Independent Claim 16

For convenience when reading the following description, Figures 1 and 4 of the present Application are reproduced immediately below the description.

Claim 16 contains the limitations that the claimed **disposable diaper 20** comprises two distinct structures, namely an **absorbent assembly 200** and a **chassis 100**. The **absorbent assembly 200** has longitudinally extending **side flaps 247**, which are attached adjacent to their ends to the **interior surface 202** of the **absorbent assembly 200**. Longitudinally extending **elastic gathering members 267** are attached adjacent to the **proximal edges 255** of the **side flaps 247**. When they contract, the **elastic gathering members 267** lift the **proximal edges 255** of the **side flaps 247** away from the **interior surface 202** of the **absorbent assembly 200**.

The present Application contains the explicit definition that the proximal edge of a longitudinally extending element is located nearer to the longitudinal axis than the distal edge of the same element is located relative to the same longitudinal axis. See page 4 at lines 19-22. Consistent with this explicit definition, the **proximal edges 255** of the **side flaps 247** are shown in the figures as being located nearer to the **longitudinal axis 42** than any other portions of the **side flaps 247**.

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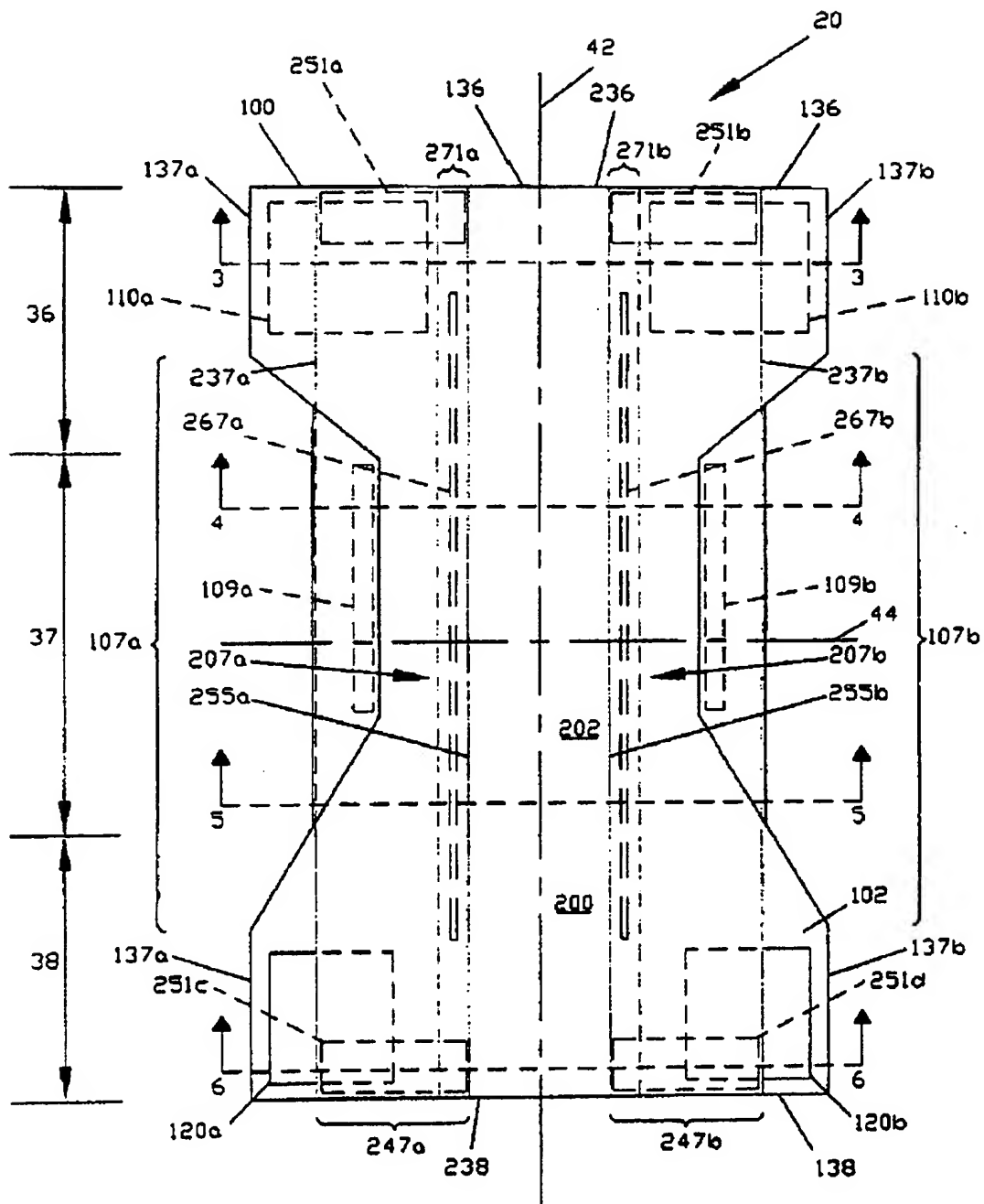


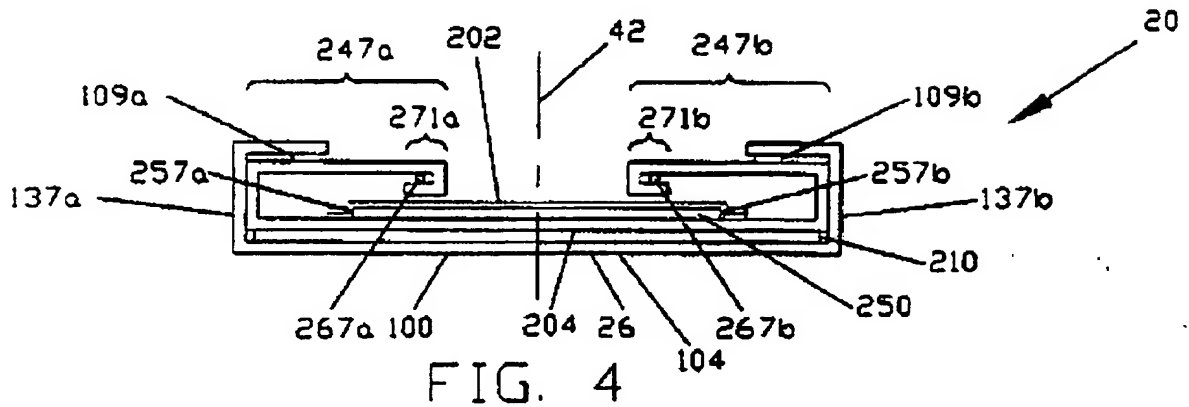
FIG. 1

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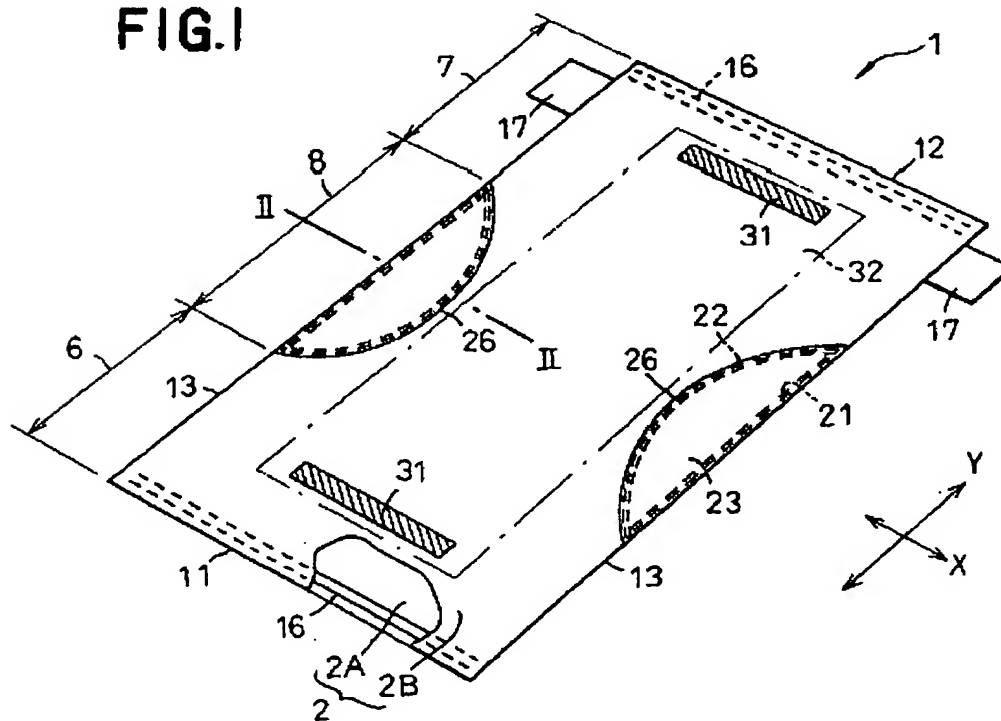
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Two of the figures from Tanji *et al.* are reproduced below for convenience when reading the following description and comparing the articles disclosed by Tanji *et al.* to the claimed disposable diaper 20. Fig. 1 shows the embodiment described by Tanji *et al.* as a *diaper cover 1* and Fig. 4 shows the embodiment described as a *disposable diaper 101*.

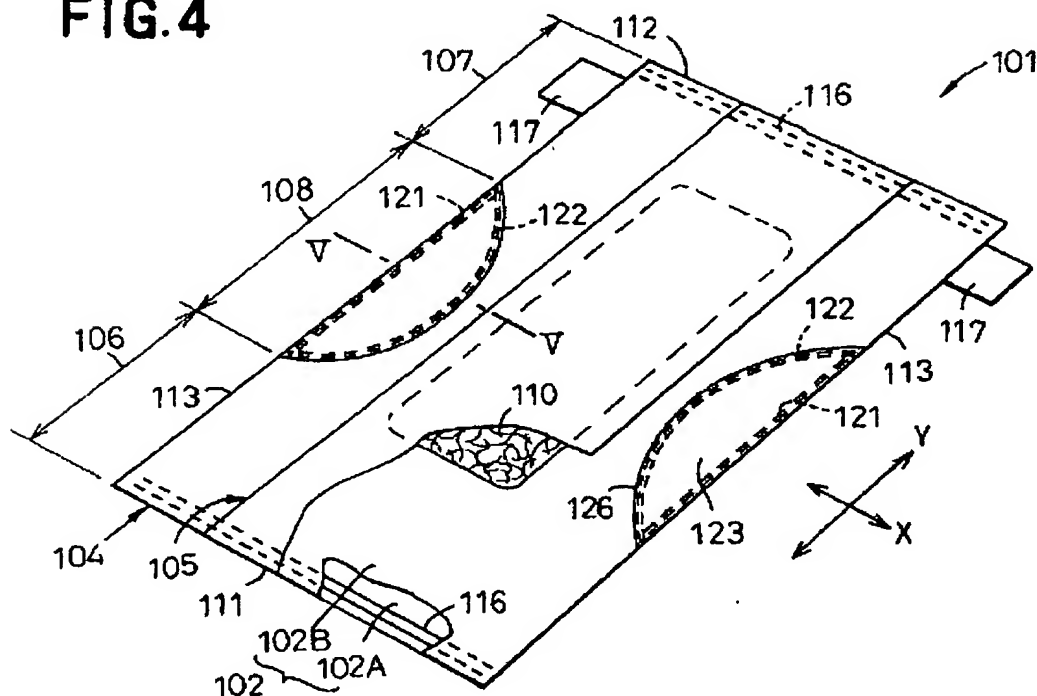


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FIG. 4

The *chassis 2, 102* correspond to the claimed **chassis 100**. The *excretion disposal material 32* in Fig. 1 and the *liquid-absorbent core 110* in Fig. 4 correspond to the claimed **absorbent assembly 200**. Therefore, the *excretion disposal material 32* and/or the *liquid-absorbent core 110* would have to include longitudinally extending side flaps in order to be analogous to the claimed **absorbent assembly 200** having **side flaps 247**. However, the articles of Tanji *et al.* do not comprise a structural analogue to the claimed **side flaps 247**, which are portions of the **absorbent assembly 200**. In the Office Action, it was alleged that the *side edge zones* of Tanji *et al.* were equivalent to the claimed **side flaps 247**, but this allegation is without foundation, because the *side edge zones 23, 123* of Tanji *et al.* are portions of the *chassis 2, 102*, rather than being portions of the *excretion disposal material 32* or the *liquid-absorbent core 110*.

In addition, the *side edge zones 23, 123* in the articles of Tanji *et al.* are not attached to the *excretion disposal material 32* or the *liquid-absorbent core 110*, as they would have to be in order to correspond to the claimed **side flaps 247**, which are attached to the **interior surface 202** of the claimed **absorbent assembly 200**.

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Furthermore, the articles of Tanji *et al.* do not comprise a structural analogue to the claimed **proximal edges 255** of the **side flaps 247**, which edges are raised away from the **interior surface 202** of the **absorbent assembly 200** by the **elastic gathering members 267**. It was alleged in the Office Action that the *first leg-hole elastic members 21, 121* are attached to the *side edge zones 23, 123* adjacent to their proximal edges and lift the *side edge zones 23, 123* away from the interior surface of the *liquid-absorbent core 110* (and presumably away from the surface of the *excretion disposal material 32* in the first embodiment). However, the *first leg-hole elastic members 21, 121* are attached to the *side edge zones 23, 123* adjacent to the distal edges of the *side edge zones 23, 123*, while the proximal edges of the *side edge zones 23, 123* are located at the *fold lines 26, 126*. It is clear that the *side edge zones 23, 123* are not free to be raised up at the *fold lines 26, 126* where their proximal edges are located. Thus, even though the *second leg-hole elastic members 26, 126* are located adjacent to the *fold lines 26, 126* (proximal edges) of the *side edge zones 23, 123*, the *side edge zones 23, 123* of Tanji *et al.* do not have proximal edges that can be lifted up.

Claim 16 also contains the limitations that the **chassis 100** includes a **fastening element 110, 120**, which is openable and refastenable. Tanji *et al.* disclose *tape fasteners 17, 117* corresponding to the claimed **fastening element 110, 120**. It was alleged in the Office Action that “[f]asteners 17 are tape fasteners and are therefore adapted to be openable and refastenable”. However, Tanji *et al.* do not describe their *tape fasteners 17, 117* as being openable and refastenable. Therefore, Tanji *et al.* do not provide support for an anticipation rejection.

Moreover, the mere fact that the *tape fasteners 17, 117* are tape fasteners does not mean that they are inherently openable and refastenable. Instead, it is well-known in the field of disposable diaper art that some tape fasteners are so aggressive that the sheet to which the tapes are fastened will tear if an attempt is made to open (peel off) the stuck tape, and some tape fasteners will not stick again after being stuck down once and then peeled off from the sheet. Reference is respectfully made to MPEP 2112 where it is pointed out that in a rejection based on inherency, the burden is on the Examiner to show that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, and that inherency may not be established by

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probabilities or possibilities, *i.e.*, the mere fact that a certain thing may result from a given set of circumstances is not sufficient. In the present rejection, the Examiner has provided no evidence whatsoever that the alleged openability and the refastenability of the *tape fasteners 17, 117* necessarily flows from the disclosure of Tanji *et al.*

Dependent Claims 17 and 18

Claims 17 and 18 depend from **Claim 16** and thereby contain all of its limitations. Therefore, the above argument applies to these dependent claims, as well.

Dependent Claim 18

Claim 18 contains the limitation that the **fastening element 110, 120** of **Claim 16** includes a **cohesive fastening element**. See page 7 at lines 6 to 27. As noted above, the *tape fasteners 17, 117* of Tanji *et al.* correspond to the claimed **fastening element 110, 120**. Therefore, the *tape fasteners 17, 117* would have to include a cohesive material in order to be analogous to the claimed **fastening element 110, 120** including a **cohesive fastening element**.

However, Tanji *et al.* do not disclose that their *tape fasteners 17, 117* are formed of a cohesive material. Therefore, Tanji *et al.* do not provide support for an anticipation rejection.

It was alleged in the Office Action that the *tape fasteners 17, 117* of Tanji *et al.* “are cohesive in that the adhesive formed thereon is capable of sticking to itself but not able to significantly stick to other materials”. However, if the *tape fasteners 17, 117* were “not able to significantly stick to other materials”, then the *tape fasteners 17, 117* could not perform their explicitly disclosed function of connecting the *front waist region 6* and the *rear waist region 7*. This fact necessarily follows from the clearly disclosed structures of the articles of Tanji *et al.*, in which the *tape fasteners 17, 117* are provided only in the *rear waist region 7*. A *tape fastener 17, 117* that could stick only to itself could not stick to the *front waist region 6* and therefore could not connect the *front waist region 6* and the *rear waist region 7*.

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Summary with respect to rejections under 35 USC § 102(b)

The cited Tanji *et al.* reference fails to disclose all of the elements of any of the rejected claims and therefore anticipation has not been shown. Accordingly, it is respectfully requested that the rejections of **Claims 16-18** be withdrawn.

Claim Rejection Under 35 U.S.C. § 103

Claim 19 was rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,461,342 to Tanji *et al.*

This rejection is hereby traversed on the ground that it was not shown in the Office Action that the requirements of MPEP 2142 or 2143 for the establishment of a *prima facie* case of obviousness have been met with respect to the rejected claim. According to MPEP 2142:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.”

Claim 19 depends from **Claim 16** and thereby contains all of its limitations. Therefore, all of the elements of **Claim 16** that are identified above as not being disclosed by Tanji *et al.* are likewise missing with respect to **Claim 19**. However, the only missing element that was addressed in the Office Action was the **mechanical fastener** that is recited in **Claim 19**, itself. Therefore, even with the proposed modification incorporated, the articles of Tanji *et al.* would still fail to include all of the elements of **Claim 19**. In other words, this obviousness rejection is incomplete because several elements *in addition to* the **mechanical fastener** would have to be supplied in order to make either of the articles of Tanji *et al.* meet all of the limitations of **Claim 19**. Put another way, Tanji *et al.* fail to teach or suggest all of the limitations of **Claim 16**, from which **Claim 19**

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depends, and the proposed modification addressing only the specific limitation of **Claim 19** fails to remedy the shortcomings with respect to the limitations of **Claim 16**.

Summary with respect to rejection under 35 USC § 103(a)

The requirements of MPEP 2142 and 2143 for the establishment of a *prima facie* case of obviousness have not been met with respect to the rejected claim. Accordingly, it is respectfully requested that the rejection of **Claim 19** under 35 USC § 103(a) be withdrawn.

Allowable Subject Matter

In the Office Action, **Claims 1-15 and 20** were stated to be allowable. It is respectfully averred that **Claims 16-19** are likewise allowable, for the reasons that are explained above.

Summary of this Reply

The rejections of **Claims 16-19** have been argued. No new matter has been added.

The allowance of all twenty pending claims is respectfully requested.

Respectfully submitted,
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